

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

9562-9

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Michele P. McMahan

Application Number

10/506,943

Filed

03/07/2005

First Named Inventor

Carl Gustavsson

Art Unit

2437

Examiner

Pham, Luu T.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 50,743

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34



Signature

Timothy J. Wall

Typed or printed name

919/854-1400

Telephone number

November 16, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒

*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**RESPONSE UNDER 37 C.F.R. 1.116 - EXPEDITED
PROCEDURE - EXAMINING GROUP 2437**

Attorney's Docket No.9562-9

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Gustavsson et al.
Application No.: 10/506,943
Filed: March 7, 2005
For: SECURITY PROTECTION FOR DATA COMMUNICATION

Confirmation No. 8802
Group Art Unit: 2437
Examiner: Luu T. Pham

Date: November 16, 2009

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Commissioner for Patents
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Alexandria, VA 22313-1450

**REASONS IN SUPPORT OF APPLICANTS' PRE-APPEAL
BRIEF REQUEST FOR REVIEW**

Sir:

This document is submitted in support of the Pre-Appeal Brief Request for Review filed concurrently with a Notice of Appeal in compliance with 37 C.F.R. 41.31 and with the rules set out in the OG of July 12, 2005 for the New Appeal Brief Conference Pilot Program, which have been extended indefinitely. If any extension of time for the accompanying response or submission is required, Applicants request that this be considered a petition therefore. The Commissioner is hereby authorized to charge any additional fee, which may be required, or credit any refund, to Deposit Account No. 50-0220.

Applicants hereby request a Pre-Appeal Brief Review (hereinafter "Request") of the claims finally rejected in the Final Office Action mailed July 27, 2009 (hereinafter "Final Action").

Applicants respectfully submit that the rejections of the currently pending claims are clearly erroneous because many of the recitations of the pending independent claims are not met by the cited references for at least the reasons discussed herein. Therefore, Applicants respectfully request review of the present application by an appeal conference prior to the filing of an appeal brief. In the interest of brevity and without waiving the right to argue additional grounds should this Petition be denied, Applicants will discuss the recitations of independent Claim 46.

Claim 46 is Patentable

The Final Action rejects Claim 46 under 35 U.S.C. §103(a) as being unpatentable over SyncML Sync Protocol, version 1.0, SYNCML CONSORTIUM, published December 7, 2000 ("SyncML"), in view of "SyncML device Management security, Version 1.1" ("SyncML-DMS"), SYNCML CONSORTIUM, published on February 15, 2002, in view of U.S. Patent Publication No. 2002/0091933 to Quick et al. ("Quick") in view of U.S. Patent Publication No. 2003/0056100 to Beatson ("Beatson") and in further view of U.S. Patent Publication No. 2003/0028805 to Lahteenmaki ("Lahteenmaki"). (Final Action, page 3.) Applicants respectfully submit that independent Claim 46 is patentable for at least the reasons that the cited references, alone or in combination, do not disclose or suggest several of the recitations therein. For example, independent Claim 46, as amended, recites:

A method for providing authentication when messages are sent between an electronic communication apparatus and a server according to a synchronization protocol in which a plurality of different authentication methods are available, comprising:

- providing an authentication method indicator that specifies an authentication method of the plurality of different authentication methods according to which the authentication is to be executed;
- incorporating into a message the authentication method indicator comprising **a plurality of authentication capabilities of the communication apparatus** among the plurality of different authentication methods; ~~and~~
- transmitting said message to said server according to an authentication protocol of the synchronization protocol;
- generating, at the server, an integrity key** that is encrypted with the public key of the electronic communication apparatus, and an authentication data value comprising an equivalent of an AKA FRESH parameter;
- sending the integrity key** and the authentication data value to the electronic communication apparatus;
- using the integrity key at the electronic communication apparatus to generate MAC values; and
- using a hashing function at the electronic communication apparatus to compute a Hashed Method Authentication Code (HMAC) on the message, wherein the specified authentication method is any of a group comprising Wireless Public Key Identity (WPKI), Wireless Identity Module (WIM) authentication. (*Emphasis added.*)

The Final Action states that SyncML at section 2.5 discloses the above highlighted recitation of Claim 46. Applicants respectfully submit that the cited portion of SyncML states:

This protocol requires the support for the basic authentication and the MD5 digest access authentication on the server layer (i.e., in SyncHdr). Both the sync client and the server can challenge for the authentication and the device receiving the authentication challenge must be able to send the authorization credentials back.

As the alleged teachings (namely, authentication capabilities of the communication apparatus) do not even appear to be contemplated in the cited portion, Applicants respectfully submit that Final Action improperly reads non-existent teachings into the reference. Additionally, the Final Action does not allege and the other references do not disclose or suggest these recitations of Claim 46.

To establish a *prima facie* case of obviousness, three criteria must be met. First, the prior art reference or references when combined must teach or suggest all the recitations of the claims. M.P.E.P. §2143. Furthermore, as recently stated by the U.S. Supreme Court, *KSR International Co. v. Teleflex Inc., et al.*, 550 U.S. 1, 14 (2007), there must be some reason to combine the references in a way that produces the claimed invention, and a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Finally, as set forth in MPEP § 2143, there must be a reasonable expectation that the modification will be successful. The teaching or suggestion to modify the references, as well as the reasonable expectation of success, must be found in the prior art and not based on the Applicant's disclosure. Failure to meet any one of these criteria -- a teaching or suggestion of all claimed elements, a reason to combine or modify the references, and a reasonable expectation of success -- is sufficient to render an obviousness rejection improper.

In this regard, the Final Action's rationale for combining the plethora of additional references (SyncML-DMS, Quick, Beatson, Lahteenmaki) to cobble together the rejection appears to rely on impermissible hindsight informed by Applicants' disclosure. For example, Beatson is generally directed to a digitized signature of an electronic documents and appears to be substantively unrelated to the authentication of messages between an electronic communication apparatus and a server. The Final Action cuts and pastes the same conclusory characterizations regarding each of the references that each is "in an analogous art." Applicants respectfully submit that, but for the roadmap of Applicants' specification, one of ordinary skill in the art would not be motivated to select and combine the elements from the references in a way that produces the claimed invention.

For example, the Final Action alleges that it would be obvious to combine the integrity key described in Quick with a combination of SyncML and SyncML-DMS, which describe communications between a server and client. Applicants note, however, that the cited portions of Quick appear to be directed to communication between a mobile unit 220 and a subscriber identification token 230 that is inserted into the mobile unit 220. In this regard, the integrity key described in Quick is not analogous to the "integrity key" that is generated at the server, as recited in Claim 46. In fact, the only similarity between the teachings alleged by the Final Action and the claim recitations appears to be common terminology.

Further, as the combination of references fails to disclose or suggest generating the integrity key in the server, then the references necessarily fail to disclose or suggest "sending the integrity key" that is generated in the server. In fact, as discussed above, the integrity key described in Quick is done so by a token that is inserted into the mobile unit. In this regard, as the combination of references fails to disclose or suggest "all" of the recitations of Claim 46, then the requirements for a finding of obviousness are not satisfied. Accordingly, Applicants respectfully submit that Claim 46 is patentable over the art of record, the allowance of which is respectfully requested.

Dependent Claims Are Patentable

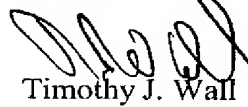
Applicants also traverse the rejection of the dependent claims. However, as each of these claims depends from a base claim that is believed to be in condition for allowance, Applicants do not believe that it is necessary to argue the allowability of each dependent claim individually. Applicants do not necessarily concur with the interpretation of these claims, nor with the bases for rejection set forth in the Final Action.

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Serial No.: 10/506,943
Filed: March 7, 2005
Page 5

CONCLUSION

For at least the foregoing reasons, Applicants respectfully request that the present application be reviewed and that the rejection of the independent claims be reversed by the appeal conference prior to the filing of an appeal brief.

Respectfully submitted,



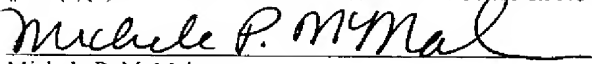
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CERTIFICATION OF TRANSMISSION

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Michele P. McMahan